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02/500 362 APPLICATION NO.	02/27/01 FILING DATE	WILLIAM FIRST NAMED INVENTOR	D.	ATTORNEY DOCKET NO. 49572 (1878)
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NM11/0418

EXAMINER

ART UNIT	PAPER NUMBER
1524	11

DATE MAILED: 04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	09/506,362	Applicant(s)	J. William et al
Examiner	J. D. Ford	Group Art Unit	1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ~~THREE~~ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on Feb 23, 2001.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1 -- 19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 1 -- 19 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

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The claims in the application are claims 1--19.

Applicants elected the instances where A is O or S.

The restriction requirement is considered sound and proper, and will be maintained.

A reference where A is N or CH₂ is an entirely different molecule capable of supporting a separate patent, in that, a reference for one would not be a reference for the other.

Claims 1--9 are rejected under 35 U.S.C. 112, 2nd paragraph. A composition claim requires an inert carrier.

In claim 1, line 1 can be given no weight, the claim is no different than a compound of the formula.

An apoptosis inducing amount is a screen that does not recite a real disease. Therefore, it does not meet the present Utility guidelines. Claim 1 is rejected as an improper joinder of independent inventions. Claim 1 should be re-written directed to the elected subject matter only.

Claim 1 is rejected under 35 U.S.C. 112, 1st and 2nd paragraph. What is the heterocyclic ring formed on page 78, middle of the page, from R₂ and R₃ together? Containing is an open term. What else does it contain? One or more is an open expression. What size ring is formed? Where is the ring supported? Where are the hetero atoms in the ring?

Claim 2 is rejected, similarly, *middle* of claim 2, "at least one hetero atom" is open. How many? Located where in the ring?

Same, claim 3.

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Claim 5 is rejected under 35 U.S.C. 112, 5th paragraph. ~~Multiple dependent claim may not be dependent on a multiple dependent claim.~~

Claims 6 and 7 and 13 are rejected under 35 U.S.C. 112, 5th paragraph. A multiple dependent claim may not be dependent on a multiple dependent claim.

Claims 8, 9, 19, 18, 17, 16 and 15 are rejected under 35 U.S.C. 112, 2nd paragraph. IUPAC names are required to determine patentability. The claims must be complete within themselves.

The drawings are not acceptable.

Claims 10--19 are rejected for the reason noted in the rejection of claims 1--9.

Compounds may not be claimed in term of uses.

Claims 10--19 violate 35 U.S.C. 101 and 35 U.S.C. 112, since they are drafted in terms of use. See Clinical Products vs. Brenner, 255 F. Supp. 151; 149 USPQ 475 (D.C. District Columbia 1966). The last few lines of claim 10 are not acceptable. Additional active ingredients PK 11195 or R5-4864 are not acceptable, as the claim would not be of the same scope as claim 1. One compound cannot be accepted as treating all tumours or cancerous condition; In re Hozumi, 226 USPQ 353, and Brenner vs. Manson, 148 USPQ 689.

Claim 14 is not a proper composition. Compound Plus an inert carrier for a specific purpose.

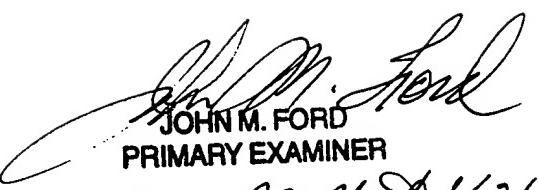
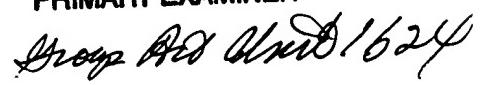
The Drawings are not acceptable See PTOL 948 form from Draftsman.

Claims 1--19 are not proper composition or method claims in this country.

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JOHN M. FORD
PRIMARY EXAMINER


J. Ford:jmr

March 14, 2001